

REMARKS

1. Status of the Claims

Claims 1-12 as filed and claims 13-14 as amended are pending. Claim 14 was converted to a method of treatment claim. No new matter has been added by these amendments.

2. Provisional Non-Statutory Double Patenting Rejection

Claims 1-14 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of co-pending Application No. 10/313,849. Since this is a provisional rejection, the Applicants respectfully defer addressing it until some claims have been allowed.

3. Rejection based on 35 U.S.C. § 112, first paragraph

Claim 14 stands rejected as allegedly not being enabled. The Office Action reads "The specification fails to provide adequate teachings how to use the currently claimed compounds. The Applicants respectfully disagree. On pages 401 to 415 of the application as filed, the diseases and/or conditions that can be treated using the compounds of the invention are discussed, as are various formulations and dosages. The Applicants submit that the disclosure in these pages enables "how to use the currently claimed compounds" in the claims. If the Office disagrees, further explanation of the rejection is requested.

The Office Action also reads "the specification fails to show which compounds are used to treat what diseases." Applicants note that on page 415 of the application, the following is stated "The compounds of the invention inhibit cleavage of APP between Met595 and Asp596 numbered for the APP695 isoform, or a mutant thereof, or at a corresponding site of a different

isoform, such as APP751 or APP770, or a mutant thereof (sometimes referred to as the "beta secretase site"). While not wishing to be bound by a particular theory, inhibition of beta-secretase activity is thought to inhibit production of beta amyloid peptide (A beta)." It is applicants' position that the claimed compounds inhibit cleavage of APP, which inhibits production of beta amyloid peptide. All of the diseases and/or conditions that are encompassed by claim 14 have been shown to be associated with the cleavage of APP and the formation of beta amyloid. Therefore, the specification does teach which compounds treat what diseases, i.e., the claimed compounds are useful in treating all of the diseases associated with the cleavage of APP and the formation of beta amyloid.

The claims also stand rejected as failing to teach how the claimed compounds can be used to prevent the disclosed diseases and/or conditions. While Applicants respectfully disagree, in order to expedite the prosecution of the application and its issuance as a patent, they have removed all references to "preventing" from claim 14. Applicants submit that the rejection based on 35 U.S.C. § 112, first paragraph has been overcome and request that it be withdrawn.

4. **Rejection based on 35 U.S.C. § 112, second paragraph**

Claim 13 stands rejected as allegedly being indefinite for failing to provide the "starting material(s) and reagents(s), and the reaction conditions to make the current compounds." In response, the Applicants have amended the claim to more clearly identify the method and intermediates that are being claimed. Support for these amendments can be found throughout the application as filed. In particular see Schemes I-XV on pages 84-112, and Examples 1-134 on pages 112-373. In light of these claim amendments, Applicants submit that the rejection of claim 13 based on 35 U.S.C. § 112, second paragraph is moot, and they request that it be withdrawn.

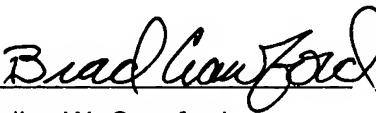
CONCLUSION

Applicants respectfully contend that all requirements of patentability have been met. Allowance of the claims and passage of the case to issue are therefore respectfully solicited.

Should the Examiner believe a discussion of this matter would be helpful, she is invited to telephone the undersigned at (312) 913-2114.

Respectfully submitted,

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By: 

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